Restriction Requirement

Applicants respectfully traverse the Examiner's restriction requirement. The Examiner has not satisfied the prima facie case for establishing that restriction of the claims in the present case is proper. Furthermore, the claimed inventions are all closely interrelated from a patentability standpoint and should be examined together. Accordingly, it is respectfully requested that the restriction requirement be withdrawn.

The Examiner states that Group I and Group II inventions are unrelated to each other. According to MPEP 808.01, **two criteria** must be met in order for the Examiner to properly conclude that inventions are unrelated: (1) the inventions must not be disclosed as capable of use together, **and** (2) the inventions must have different modes of operation, different functions, or different effect. (MPEP 808.01) In the present case, the Examiner concludes that Group I and Group II inventions have different functions and are thus unrelated because Group I is directed to sterol compositions and Group II is directed to food products. Merely concluding that the inventions have different functions, especially as here where the Examiner has not explained how the two groups allegedly function differently, is insufficient basis for concluding that Group I and Group II are unrelated. The Examiner must **also** satisfy the first requirement set forth in MPEP 808.01 and show that the inventions are not disclosed as capable of use together; this, the Examiner has not done.

Throughout the Claims and the Specification, the Group I sterol compositions and the Group II food products are clearly shown to be disclosed as capable of use together. Furthermore, not only are Group II Claims 13-37 and 54-46 capable of being used together with Group I sterol compositions, they are required to be used as such; these Group II claims are dependent upon and comprise the sterol ester compositions of Group I claims, thus requiring their use together. Also, the invention of Claim 41, directed to a salad oil or cooking oil comprising sterol esters, is clearly capable of use with the Group I sterol compositions. Not only does the invention of Claim 41 comprise sterol esters, but the Specification states that "the end use of the sterol ester compositions is described primarily herein in terms of a preferred cooking or salad oil." (Specification, p. 19, lines 10-12; see also p. 19, lines 13-29) Thus, because the Group I sterol compositions are disclosed as capable of use together with the Group II food products, the criteria for restriction set forth in MPEP 808.01 have not been met. Accordingly, the Examiner's restriction requirement is improper and should be withdrawn.

Furthermore, the Examiner states that Group III and I, and Group IV and II, are related as process of making and product made. MPEP 806.05(f) states that a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process as claimed can be used to

make other and materially different product, or (2) that the product as claimed can be made by another and materially different process. In the present case, the Examiner concludes that "different solvents or different catalysts may be employed in methods for preparing sterol ester compositions herein." (10/10/01 Office Action, p. 3) It should be noted, however, that no specific solvents or catalysts are set forth in the process claims. Thus, the Examiner's conclusion that "different solvents or different catalysts may be employed" in the methods is irrelevant, since no specific solvents or catalysts are specified. Thus, the Examiner has not met the burden for establishing that restriction of the Group III and the Group IV process claims from those of the Group I and the Group II product claims is proper. Accordingly, it is respectfully requested that the restriction requirement be withdrawn.

In addition, the Examiner has not set forth any reason why the Group III process claims should be restricted from the Group IV process claims. According to MPEP 808, every requirement to restrict must include the reasons why the inventions as claimed are either independent or distinct, as well as the reasons for insisting upon restriction therebetween. In the present case, no reasons are given by the Examiner for the restriction of the process claims of Group III from those of Group IV. Accordingly, the Examiner has not met the burden for establishing that restriction of the Group III from the Group IV process claims is proper and the restriction requirement should be withdrawn.

The Examiner's statement that the "search for all inventions would place an undue burden on the examiner in view of the corresponding diversity in the field of search for each" (10/10/01 Office Action, p. 3) is without merit. The Examiner has classified all four groups into the same class and subclasses; thus, examination of only one search classification would be required. In fact, prosecuting all four groups together would eliminate duplication of search efforts, thereby simplifying Patent Office examination work.

Furthermore, Applicants respectfully disagree that the inventions are "distinct . . . and have acquired a separate status in the art because of their recognized divergent subject matter" (10/01/01 Office Action, p. 3), as argued by the Examiner. Rather, as discussed above, the claimed inventions are all closely interrelated from a patentability standpoint. Even if the inventions were independent or distinct, this would not provide sufficient basis to restrict the claims. According to MPEP 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (MPEP 803)

In the event the Examiner persists in the restriction requirement, Applicants hereby affirm the provisional election of claims 13-37, 41, and 54-56 (Group II) for prosecution,

holding claims 1-12, 38-40, and 42-53 in abeyance under the provisions of 37 C.F.R. 1.142(b) until final disposition of the elected claims.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the restriction requirement and allow claims 1-56 to be prosecuted in the same application. In the event that the Examiner's restriction requirement is made final, Applicants reaffirm the provisional election of claims 13-37, 41, and 54-56 (Group II) for prosecution, holding claims 1-12, 38-40, and 42-53 in abeyance under the provisions of 37 C.F.R. 1.142(b) until final disposition of the elected claims.

Respectfully submitted,

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